

REMARKS

Claims 1-18 are pending in the above-identified application and have been subjected to restriction by the Office Action under 35 U.S.C. §121 as follows:

- I. Claims 1-14, drawn to an aqueous colloidal gold solution, classified in class 106, subclass 31.65.
- II. Claims 15-18, drawn to a gold coated or impregnated substrate, classified in class 428, subclass 457+.

In support of the present Restriction Requirement, the Office Action has alleged that Groups I and II, related as combination and subcombination, are distinct as “the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require the aqueous medium. The subcombination has separate utility such as a solution to make a cast film.” In addition, the Office Action also alleged the inventions are distinct as they “have acquired a separate status in the art as shown by their different classification...”

As indicated hereinabove and in order to be fully responsive to the requirement for restriction imposed by the Office Action, applicants provisionally elect, with traverse, to prosecute the subject matter of Group I, i.e., Claims 1-14.

In addition, applicants reserve the right to file a divisional application directed to the non-elected subject matter.

Notwithstanding the foregoing, applicants hereby traverse, pursuant to 37 C.F.R. §§1.111 and 1.143, the requirement for a restriction and request reconsideration thereof in view of the following remarks.

Applicants respectfully request that the Restriction Requirement be withdrawn since it is not in compliance with 35 U.S.C. §121 and 37 C.F.R. §§1.141 and 1.142.

35 U.S.C. §121 provides that the Commissioner may restrict an application when two or more independent and distinct inventions are claimed in a single application (emphasis added). Similarly, 37 C.F.R. §1.141(a) permits restriction on condition that independent and distinct inventions are found within one application. Only the statutory requirement that the various groups of claims are “distinct” has been proffered as a basis for requiring the restriction. Even assuming, pro arguendo, that the Office Action was correct with respect to distinctiveness, there is absolutely no indication in the Office Action that Groups I-II are also independent. In fact, applicants submit that there is an interdependence between each of the groups alleged to be patentably distinct.

MPEP §802.01 defines independent as follows:

The term “independent” (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is they are unconnected in design, operation or effect...

Applicants respectfully submit that the subject matter in Groups I and II are connected in design, operation or effect and are thus not dependent.

The subject matter of Group I is inter alia, directed to an aqueous colloidal gold solution comprising an aqueous medium and (a) gold particles in colloidal form, (b) a compound having a polar tertiary amino group conjugated via a hydrophobic aromatic residue with a weaker alkaline group which can also be a part of the aromatic residue, and (c) a stabilizer comprising a mercapto group and an acidic group, while Group II is directed to a gold-coated or –impregnated substrate obtainable by application of the colloidal gold solution referred to in Group I onto a substrate or by impregnation of the substrate and evaporation of the aqueous medium. The two groups of claims are clearly linked by the presence of features (a), (b) and (c) as noted above and defined in claim 1. Claim 15 is employing the aqueous colloidal gold solution of claim 1. The presence or absence of the aqueous medium, as suggested by the Office Action, does not justify the classification of these claims as two separate inventions. Thus, Groups I and II are related and are not independent. They therefore have a disclosed relationship. Consequently, because the Office Action has not even alleged the statutory required “independence” of these groups and further because these groups of claims are connected in design, operation and/or effect and are therefore not independent, the claims which the Office Action has grouped separately are not “independent and distinct” so as to justify the Restriction Requirement. It is therefore respectfully submitted that the Restriction Requirement is improper and cannot be maintained.

In addition, the courts have recognized that it is in the public interest to permit applicants to claim several aspects of their invention together in one application,

as the applicants have done herein, so as to encourage applicants to provide a more detailed disclosure of all aspects of their invention. The CCPA has observed:

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner recognized by 35 U.S.C. §112, all aspects as to what they regard as their invention, regardless of the number of statutory classes involved.

In re Kuehl, 456 F2d 658, 666, 117 U.S.P.Q. 250, 256 (CCPA 1973).

Applicants respectfully suggest that in view of the continued increase of official fees and the potential limitation of applicants' financial resources, a practice which arbitrarily imposes a Restriction Requirement may become prohibitive and thereby contravenes the constitutional intent to promote and encourage the progress of science and the useful arts. Moreover, under the regulatory changes as a consequence of the General Agreement on Trade and Tariffs (GATT), the applicants are required to either conduct simultaneous prosecution with attendant filing fees and costs or face a compromise of the term of their patent assets.

It is vital is filed to all applicants that Restriction Requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double-patenting. The third sentence of U.S.C. §121, which states that a patent issuing on a parent application "shall not be used as a reference" against a divisional application or a patent

issued thereon, does not provide comfort against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that §121 protects a patentee from an allegation of same-invention-double-patenting, Studiengesellschaft Kohle GmbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 288 U.S.P.Q. 837, 840 (Fed. Cir. 1986); and in Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990), that court held that §121 does not insulate a patentee from an allegation of “obviousness-type” double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

All these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which applicant’s legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect patentee’s rights and to serve the public’s interest in the legitimacy of issued patents, applicant respectfully urges the Examiner not to require restriction in cases such as the present application.

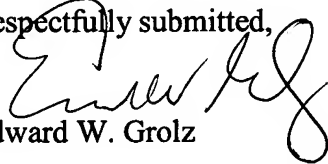
The Office Action also seems to suggest that a prior art search requiring search in more than one classification is sufficient criteria for maintaining a restriction to allegedly different patentable inventions. This, of course is error. It simply does not comply with the provisions under 35 U.S.C. §121. (See In re Kuehl, *supra*).

The classification system is an unreliable basis for requiring restriction between claims to the various aspects of applicants' unitary invention, because the system exhibits considerable overlap in technical definitions. In particular, the definitions of subclasses in the classification system do not prevent an Examiner from basing patentability decisions, as to claims he assigned to one group, on patent references found in the subclass(es) with which he associated another group of claims.

Furthermore, the classification system is a poor basis for requiring restriction between related aspects of an invention because classifications and definitions change over time. Thus, a classification that might have seemed to support restriction at a given time could change, thereby casting a shadow over the propriety of the restriction requirement later on during the term of the patents issuing from parent and divisional applications. Indeed, classifications seem largely to change in response to considerations of administrative convenience, and often in response to nothing more than growth in the number of patents in a given class or subclass. These considerations have nothing to do with whether the subject matter of patents assigned to different classifications is "independent and distinct" as those terms are used in 35 U.S.C. §121, which fact proves that basing restriction requirements on the classification system is improper.

Hence, it is respectfully requested that the United States Patent and Trademark Office reconsider and withdraw the requirement for restriction pursuant to 35 U.S.C. §121 and provide an action on the merits with respect to all of the claimed subject matter.

Respectfully submitted,


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Enc.